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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,878	10/31/2001	E. Skott Greenhalgh	24463-A USA	7320

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EXAMINER

BARRETT, THOMAS C

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 02/02/2004

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/998,878

Applicant(s)

GREENHALGH, E. SCOTT

Examiner

Thomas C. Barrett

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) 18-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2,4. 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

Applicant's election with traverse of Species II, Sub-species i in Paper No. 8 is acknowledged. The traversal is on the ground(s) that there would not be a serious burden on the Examiner. This is not found persuasive because a species restriction does not require a showing of serious burden. MPEP 808.01(a) states, "Where there is no disclosure of relationship between species, they are independent inventions and election of one invention following a requirement for restriction is mandatory even though applicant disagrees with the examiner. There must be a patentable difference between the species as claimed. Since the claims are directed to independent inventions, restriction is proper pursuant to **35 U.S.C. 121**, and it is not necessary to show a separate status in the art or separate classification." If the Applicant were to argue that the inventions are not independent, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

The requirement is still deemed proper and is therefore made FINAL.

Claims 20 and 22-30 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 8.

Art Unit: 3738

The Examiner has rejoined claim 4, which had not been elected by the Applicant. Sub-species i was directed towards the secondary filamentary members comprising a metal, wherein claim 4 is directed towards the first filamentary members.

The Examiner has also withdrawn claims 18 and 21 as being directed towards a non-elected Species. The second filamentary members of claim 18 are made of textured yarns, while the second filamentary members of claim 21 are made of an elastic yarn. Neither claim is directed to a metal.

Specification

The use of the trademark "nitinol" has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner that might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 3-4 and 11-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 3738

Claim 3 contains the trademark/trade name "nitinol". Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe a type of nickel/titanium alloy and, accordingly, the identification/description is indefinite. See MPEP 2173.05(u).

Line 4 of claim 11 states, "said second and third filamentary members" yet there are no additional limitations of said members. It is unclear whether the phrase was added in error or further limitations of said members were omitted.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Jayaraman (WO 99/21506). Jayaraman discloses a tubular graft (10) comprising: first

Art Unit: 3738

filamentary members (23) made of polyester interlaced with secondary filamentary members (35) made of Nitinol (p6, lines 13-25), which is of a higher tensile strength and has a greater denier than the first members.

Claims 1 and 8-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Rakos et al. (EP 0 938 878). Rakos et al. discloses a tubular graft comprising: first filamentary members (12) interlaced with second and third filamentary members (14) made of Nitinol placed circumferentially around the graft (p 3, lines 1-4, Figure 2). Nitinol is a different color than Dacron, and therefore the second and third filamentary members are a different color than the first filamentary members. The circumferential second and third filamentary members of Figure 2 are in a spaced relation to each other and would be adjacent to an end of the graft. Due to the greater strength of the Nitinol, the second and third filamentary members reinforce the space between them to act as an attachment region.

Claims 1, 5-6 and 16-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Liebig et al. (4,047,252). Liebig et al. discloses a tubular graft comprising: first single ply filamentary members interlaced with a second circumferential multi-ply filamentary member of the same denier (col. 3, line 49-col. 4, line 31). The second multi-ply filamentary member reduces porosity (col. 4, lines 62-64), therefore inherently inhibits leaking. A third filamentary member in spaced relation to the second filamentary member defines a space in between that can be used for attachment (FIG. 2).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 8-10 and 13-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drasler et al. (6,287,335 B1) in view of Jayaraman (6,224,625 B1). Drasler et al. discloses a tubular graft (Figs. 14 and 15) comprising first polymeric filamentary members (635 and 640) interlaced with circumferential second, third (660) and longitudinal filamentary members (655) of greater denier however Drasler et al. fails to disclose the graft having a stent circumferentially around the graft and attached at an end. Jayaraman teaches a stent extending circumferentially around a graft, attached at the ends of the graft (Fig. 1), which is capable of a high degree of expansion, yet retains a low profile (col. 1, lines 40-46). It would have been obvious to one of ordinary skill in the art to combine the teaching of a stent extending circumferentially around a graft, as taught by Jayaraman, to a tubular graft as per Drasler et al., for a stent-graft capable of a high degree of expansion, yet retaining a low profile. Please Note: the stent would inherently engage and be supported by the second, third and longitudinal filamentary members of the Drasler et al. graft as seen in Figs. 13J, 14 and 15 (col. 56, lines 37-64).

Please Note: A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to

Art Unit: 3738

patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim, i.e. "**for** attachment of said graft".

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas C. Barrett whose telephone number is (703) 308-8295. The examiner can normally be reached Tuesday-Friday between 9:00 A.M. and 6:00 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (703) 308-2111. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.



Thomas Barrett
January 24, 2004